



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/618,499	07/11/2003	John C. Colvin	124-0002US-D	5385

29855 7590 08/10/2005

WONG, CABELLO, LUTSCH, RUTHERFORD & BRUCCULERI,
P.C.
20333 SH 249
SUITE 600
HOUSTON, TX 77070

EXAMINER

TRAN, THAO T

ART UNIT	PAPER NUMBER
----------	--------------

1711

DATE MAILED: 08/10/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/618,499

Applicant(s)

COLVIN ET AL.

Examiner

Thao T. Tran

Art Unit

1711

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10 June 2005.
2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-15, 17-34, 37-39 and 41 is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) 1-15, 17-34, 37-39 and 41 is/are rejected.
7) ☐ Claim(s) _____ is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Response to Amendment

1. This is in response to the Amendment filed 6/10/2005.
2. Claims 1-15, 17-34, 37-39, and 41 are currently pending in this application. Claims 16, 35-36, 40, and 42-44 have been canceled. Claim 41 has been amended in this Reply.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. Claims 1-15, 17-34, 37-39, and 41 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The amended claim 41 introduces the new limitation "about 0.1 to less than 2% by weight" of the moisture content in the substrate, has no proper support in the specification as originally presented.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

Art Unit: 1711

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 1-15, 17-34, 37-39, and 41 are rejected under 35 U.S.C. 103(a) as being unpatentable over Diehr et al. (US Pat. 3,870,665), in view of Mente et al. (US Pat. 6,458,238).

In regards to claims 1-5, 17-23, 33-34, and 37-41, Diehr teaches a sheet or board for building purposes, comprising a lignocellulosic material, impregnated with an organic polyisocyanate (see abstract; col. 1, ln. 6-27). The lignocellulosic material used can be chipboard, fiberboard, wood, or straw (see col. 1, ln. 32-34; col. 4, ln. 46-51). The isocyanate is diphenylmethane diisocyanate (methylene diphenyl diisocyanate) (see Example 1). Diehr further teaches the surface of the board to be smooth (see Example 8).

Diehr further teaches the lignocellulosic material containing 7% moisture content before impregnation of polyisocyanate (see Examples 9-10). However, Diehr does not teach the use of lignocellulosic material containing about 0.1 to 2.5%.

Mente teaches lignocellulosic articles, wherein the lignocellulosic material contains a moisture content of 2-15% weight for the binder resin to be efficient at forming the article (see abstract; col. 4, ln. 34-41), approximating the instantly claimed range. Therefore, it would have been obvious to one of ordinary skill in the art, at the time the invention was made, to have employed the lignocellulosic material having the moisture content, as taught by Mente, in the making of Diehr's sheet or board, for the purpose of enhancing the efficacy of the forming the article.

Although Diehr is silent with respect to a low-gloss surface or that the impregnated lignocellulosic material is substantially non-conductive, since the reference teaches the same

Art Unit: 1711

product containing the same chemical constituents, the board of the reference would inherently have the same properties, such as low-gloss surface and substantially non-conductive, as the presently claimed invention.

With respect to process limitations, such as how the lignocellulosic material is being formed or how impregnation is carried out, it has been within the skill in the art that process limitations would have no significant patentable weight when a product claim is being considered. See MPEP 2113.

In regards to claims 6-14 and 24-32, Diehr teaches the lignocellulosic material to be used in building purposes such as veneer, sheets, and the like (see col. 1, ln. 6-21). Hence, although the reference does not specifically teach the material to be used as construction components as recited in the instant claims, it would have been obvious to one of ordinary skill in the art, at the time the invention was made, that these structures would have been variations in the use of the lignocellulosic material.

Response to Arguments

7. Applicant's arguments filed 6/10/2005 have been fully considered but they are not persuasive.

As pointed out in paragraph 6 above, the Diehr combination discloses a moisture content of 2-15% by weight is proximate to the instantly claimed range of 0.1 to less than 2%. With respect to the arguments that Mente teaches away from a moisture content of less than 2%, it is hereby noted that negative teachings are also indication of a known fact taught in the prior art. Thus, the Diehr combination would be obvious over the presently claimed invention.

Art Unit: 1711

Conclusion

8. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thao T. Tran whose telephone number is 571-272-1080. The examiner can normally be reached on Monday-Friday, from 9:00 a.m. - 5:30 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Seidleck can be reached on 571-272-1078. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Art Unit: 1711

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

tt
August 8, 2005



**THAO T. TRAN
PATENT EXAMINER**